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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,268	09/27/2004	Stefan Berg	100632-1P US	5329

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ASTRA ZENECA PHARMACEUTICALS LP  
GLOBAL INTELLECTUAL PROPERTY  
1800 CONCORD PIKE  
WILMINGTON, DE 19850-5437

EXAMINER
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CHUNG, SUSANNAH LEE

ART UNIT	PAPER NUMBER
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1626

MAIL DATE	DELIVERY MODE
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07/20/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/509,268	Applicant(s) BERG ET AL.	
	Examiner Susannah Chung	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 18-40 and 42-50 is/are pending in the application.
- 4a) Of the above claim(s) 18-33 and 43-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 34-40, 42 and 50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/27/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

Claims 1-10, 18-40, and 42-50 are pending in the instant application. Claims 11-17 and 41 are canceled.

#### ***Priority***

This application is a 371 of PCT/SE03/00508, filed 03/28/2003.

Acknowledgment is made of applicant's claim for foreign priority under 35

U.S.C. 119(a)-(d) by application no. 0200979-3 filed in the Swedish Patent Office on 03/28/2002, which papers have been placed of record in the file. The application names an inventor or inventors named in the prior application.

#### ***Response to Election/Restrictions***

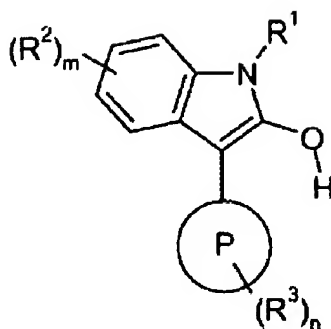
Applicant's election without traverse of Group I in the reply filed on 05/21/2007 is acknowledged. Specially, the election for search and examination purposes of the compound of formula (Ia), wherein P is a 6-membered ring containing one nitrogen, R1 is hydrogen, R2 is C0-6alkylcyano, R3 is C0-6alkylR4R5, and R4 and R5 may together form a 6 membered heterocyclic ring containing one nitrogen and one oxygen.

#### ***Scope of the Elected Invention***

Claims 1-50 are pending in this application.

The scope of the elected subject matter that will be examined and searched is as follows:

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Compounds of formula (I), , depicted in claim 1, page 2,

wherein:

P is a 6-membered heterocyclic ring containing 1 nitrogen atom,

R<sup>1</sup> is hydrogen,

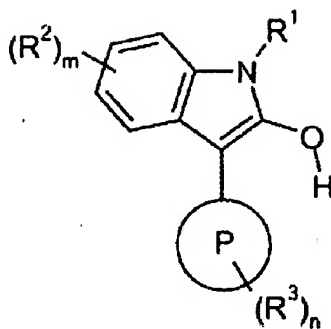
R<sup>2</sup> is C0-6alkylcyano,

R<sup>3</sup> is C0-6alkylR<sup>4</sup>R<sup>5</sup>, and R<sup>4</sup> and R<sup>5</sup> may together form a 6 membered heterocyclic ring.

### *Scope of Withdrawn Subject Matter*

Claims 18-33 and 43-49 are withdrawn from further consideration by the examiner, 37 C.F.R. §1.142(b), as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference, which anticipates one group, would not render obvious the other.

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Compounds of formula (I),  
 wherein:

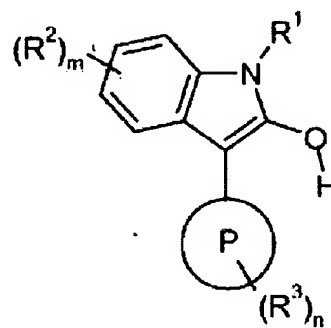
P is not a 6-membered heterocyclic ring containing 1 nitrogen atom,

R<sup>1</sup> is not hydrogen,

R<sup>2</sup> is not C0-6alkylcyano,

R<sup>3</sup> is not C0-6alkylR<sup>4</sup>R<sup>5</sup>, and R<sup>4</sup> and R<sup>5</sup> may together form a 6 membered heterocyclic ring.

### *Status of Claims*



The elected species, i.e. Compounds of formula (I),  
 in claim 1, page 2, wherein: P is a 6-membered heterocyclic ring containing 1-3 nitrogen atoms,  
 R<sup>1</sup> is hydrogen, R<sup>2</sup> is C0-6alkylcyano, R<sup>3</sup> is C0-6alkylR<sup>4</sup>R<sup>5</sup>, and R<sup>4</sup> and R<sup>5</sup> may together form  
 a 6 membered heterocyclic ring, is anticipated by the prior art and rejected. Pursuant to MPEP §  
 803.02 examination of the non-elected species will be held withdrawn.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5-7, 10, and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Bruni, et al (Annali di Chimica, 1967, Vol. 57, Issue 6, pages 688-97, especially page 693).

Applicants claims of substituted indole compounds relate to compounds found in Bruni. Bruni discloses compounds that anticipate the instantly claimed compounds, wherein P is a 6-membered heterocyclic ring containing 1 nitrogen atom, R1 is hydrogen, R2 is C0-6alkylcyano, R3 is C0-6alkylR4R5, and R4 and R5 may together form a 6 membered heterocyclic ring. (See Bruni et al., page 693, compound of 3-(2-quinolyl)-indol-2-ol, CAS RN 16176-50-4.)

***Obviousness Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10, 34-40, 42, and 50 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 34-46 of copending Application No. 10/572,778. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

Instant claims 1-10, 34-40, 42, and 50 and copending claims 34-36 are directed to the same compounds of the formula (Ia) and (Ib). Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim the same generic and specific compounds. One skilled in the art would have been motivated to make the compounds of the instant application when faced with the copending application and vice versa.

### *Specification*

The title of the invention is not descriptive. The current title is "Compounds." A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title, which is found in copending application 10/572,778 is suggested:  
3-Heterocyclyl-Indole derivatives as inhibitors of glycogen synthase kinase 3 (GSK3).

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***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susannah Chung whose telephone number is (571) 272-6098.

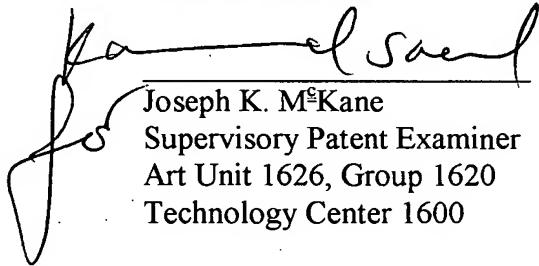
The examiner can normally be reached on M-F, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLC

KAMAL A. SAEED, PH.D.  
PRIMARY EXAMINER



Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626, Group 1620  
Technology Center 1600

Date: 13 July 2007